

II. The Rejection Under 35 U.S.C. § 112, Second Paragraph

In the Final Action, the Examiner has erroneously imposed a rejection of claim 26 as being indefinite. Claim 26 recites an isolated nucleic acid molecule “consisting essentially of” residues from a selected group. According to the Examiner, “[t]he phrase is not defined by the specification, and it is unclear what elements of a nucleic acid sequence are intended to be included or excluded by use of the phrase”. *Id.*

Applicants disagree with this assertion. It is axiomatic that claims are always construed in light of the specification, of which they are a part. *Netword L.L.C. v. Centraal Corp.*, 242 F.3d 1347, 1352, 58 U.S.P.Q. 2d 1076, 1079 (Fed. Cir. 2001); *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1118, 1 U.S.P.Q. 2d 1563, 1566 (Fed. Cir. 1987). The test for determining whether terms in a given claim are indefinite is whether one skilled in the art would understand what is claimed. *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 18 U.S.P.Q.2d 1016 (Fed. Cir. 1991), *cert. denied*, 112 S.Ct. 169 (1991). A person of ordinary skill in the art would understand the metes and bounds of claim 26 when read in light of the disclosure of the specification.

Moreover, it is well settled that the term ‘consisting essentially of’ includes not only what is specifically recited in the claim, but also any other materials which “do not materially affect the basic and novel characteristic(s)” of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (C.C.P.A. 1976). The specification teaches, for example, that the nucleic acid molecules of claim 26 may include various substitutions, additions, and deletions without materially altering the novel characteristics of the claimed invention. *See*, for example, specification at page 63, line 15 through page 66, line 7. The Examiner has not shown that one skilled in the art would have any difficulty in determining the meaning of the phrase “consisting essentially of” or of being reasonably apprised of the scope of claim 26 and, as such, has not meet the burden to impose a rejection of the claim as being indefinite. Therefore, the rejection of

claim 26 under 35 U.S.C. § 112, second paragraph, is improper. However, to facilitate the issues on appeal, Applicants have cancelled claim 26, thus rendering the outstanding rejection under 35 U.S.C. § 112, second paragraph, moot.

III. The Rejection Under 35 U.S.C. § 112, First Paragraph

In the Final Action, the Examiner has erroneously imposed a rejection of claim 26 as being directed to subject matter that was not described in the specification as filed and is allegedly new matter. Final Action at pages 5-6. The Final Action contends that “[t]he originally filed claims do not recite any nucleic acid molecules or sequences ‘consisting essentially of’ specific residues, the specification does not define what is meant by a nucleic acid molecule ‘consisting essentially of’ certain residues”. *Id.* at page 6. This rejection is erroneous and has been overcome by the arguments stated above regarding indefiniteness because it is well-established law that “[t]he test for sufficiency of support ... is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’ ” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed.Cir.1991), *citing Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed.Cir.1985). Unless and until the Examiner comes forth with evidence to demonstrate that Applicants had not adequately described the claimed subject matter as of the filing date of the application, the rejection is improper. However, to facilitate the issues on appeal, Applicants have cancelled claim 26, thus rendering the outstanding rejection under 35 U.S.C. § 112, first paragraph, moot.

Applicants believe that the present Amendment is in proper condition for entry in this application. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-2387, referencing docket number 16517.233.

Respectfully submitted,



Holly Logue Prutz (Reg. No. 47,755)

June E. Cohan (Reg. No. 43,741)

David R. Marsh (Reg. No. 41,408)

Date: October 10, 2002

Arnold and Porter
555 Twelfth Street, N.W.
Washington, DC 20004-1206
(202) 942-5000 telephone
(202) 942-5999 facsimile

Marked up Version of Amended Claims

10. (Twice Amended) An isolated nucleic acid molecule comprising a sequence that hybridizes under conditions of 2.0 X sodium chloride/sodium citrate (SSC) at about 65°C to a nucleic acid molecule having a sequence selected from the group consisting of SEQ ID NOs: [1,] 100, 147, 153, 161, 180, 199, **[and]** 232 and complements thereof.

11. (Twice Amended) The isolated nucleic acid molecule, according to claim 10, wherein said isolated nucleic acid molecule comprises a nucleic acid sequence selected from the group consisting of **[SEQ ID NO: 1,]** SEQ ID NO: 100, SEQ ID NO: 147, SEQ ID NO: 153, SEQ ID NO: 161, SEQ ID NO: 180, SEQ ID NO: 199, and SEQ ID NO: 232.

12. (Twice Amended) **[The] An** isolated nucleic acid molecule **[according to claim 10, wherein said isolated nucleic acid molecule comprises] comprising** a nucleic acid sequence of SEQ ID NO: 1.

16. (Twice Amended) An isolated nucleic acid molecule comprising a nucleic acid sequence of SEQ ID NO: 158 or complement[s] thereof.